

### ***REMARKS***

This is a full and timely response to the final Office Action mailed on January 21, 2004 (Paper No. 21). Claims 23 and 26 are canceled and claims 61-62 are newly added. Accordingly, claims 21, 22, 24, 25, and 27-62 are now pending in the present application. Reconsideration and allowance of the application and presently pending claims are respectfully requested in view of the foregoing remarks.

A. Interview Summary

Applicants first wish to express their sincere appreciation for the time that Examiner spent with Applicant's representative during a telephone discussion on April 26, 2004, regarding the outstanding Office Action. During the discussion, the Examiner agreed that the cited *Schlarb* reference could be disqualified under §103(c) if Applicants meet the requirements. Applicants respectfully submit that Applicants meet the requirements under §103(c) as provided below. Accordingly, Applicants respectfully request that the cited *Schlarb* reference be disqualified as a cited reference.

B. Response to Claim Rejection Under 35 U.S.C. §112

Applicants appreciate the Examiner's thorough review of the Application, particularly claim 24 that depends on claim 3. Applicants have amended claim 24 to depend on claim 21. Applicants respectfully request that the objection to claim 24 be withdrawn.

C. Response to Claim Rejection Under 35 U.S.C. §102

Claims 21-22 and 41-42 stand rejected under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Patent No. 5,900,916, to *Pauley*. Claims 39-40 and 59-60 stand rejected under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Patent No. 6,115,080, to *Reitmeiere*.

Claims 21 and 41 are amended to include the steps/features/elements of claim 23, which stands rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,900,916, to *Pauley* in view of U.S. Patent No. 6,590,618, to *Park* and U.S. Patent No. 6,243,145, to *Schlarb*. Thus, Applicants will provide reasons of allowance for claims 21-22 and 41-42 under 35 U.S.C. §103.

D. Response to Claim Rejections Under 35 U.S.C. §103

Claims 21 and 41 are amended to include claim 23. Claims 23-25, 27-38, 43-45, 47-55, 57, and 58 stand rejected under 35 U.S.C. §103(a) as being unpatentable *Pauley* in view of *Park* and *Schlarb*. Claims 26, 46, and 56 stand rejected under 35 U.S.C. §103 as allegedly being unpatentable over *Pauley* in view of *Park* and *Schlarb* and in further view of U.S. Patent No. 4,809,069, to *Meyer*. Applicants respectfully traverse this rejection.

In order for a claim to be properly rejected under 35 U.S.C. §103, the teachings of the prior art reference must suggest all features of the claimed invention to one of ordinary skill in the art. *See, e.g., In re Dow Chemical*, 837 F.2d 469, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988); *In re Keller*, 642 F.2d 413, 208 U.S.P.Q. 871, 881 (C.C.P.A. 1981).

Applicants have canceled claims 23 and 26 without prejudice, waiver, or disclaimer. Therefore, rejection of claims 23 and 26 is rendered moot. Applicants are not addressing the validity of all assertions made by the Examiner regarding claims 23 and 26 since the validity of such assertions may not be relevant to the allowance of the currently pending claims 21, 22, 24, 25, and 27-60. Therefore, Applicants should not be presumed to agree with any statements made by the Examiner regarding claims 23 and 26 unless otherwise specifically indicated by Applicants.

In the Office Action, it was admitted that “*Pauley* does not disclose receiving program guide data, and displaying information related to the first/second program in the first/second program display areas.” (Page 4 of the Office Action Paper No. 11). In this regard, the Office Action uses *Schlarb* and *Park*. The Office Action alleges that “*Schlarb* discloses in Fig. 3, a video window 305 with program information 310 displayed below, including channel number in area 315; program guide information is downloaded to memory 250 within terminal 120 from headend 105 (col. 3, lines 12-15).” (Page 4 of the Office Action, Paper No. 11). The Office Action further alleges that “*Park* discloses in Fig. 3A, a video window 2, and 4 in which channel number identification are shown for each tuned program. Therefore, it would have been obvious to one skilled in the art at the time of the invention to modify *Pauley* to receive program information to display in the video as taught by *Schlarb* and to display identification information as taught by *Park* in order to enable a user who is watching [TWO] programs simultaneously to

easily identify the channel of the program they are watching.” (Page 4 of the Office Action, Paper No. 11).

Applicants respectfully submit that the *Schlarb* reference is disqualified as prior art in the instant application under 35 U.S.C. §103(c). As recited in the MPEP §706.02(l)(3):

“Examiners are reminded that a referenced used in an anticipatory rejection under 35 U.S.C. §102(e), (f), or (g) is not disqualified as prior art if evidence is provided to show common ownership by, or an obligation of assignment to, the same person at the time the invention was made. Such a commonly owned reference is only disqualified when (A) proper evidence is filed, (B) the reference only qualifies as prior art under 35 U.S.C. §102(f) or (g), or 35 U.S.C. §102(e) for applications filed on or after November 29, 1999, and (C) the reference was used in an obviousness rejection under 35 U.S.C. §103(a).”

Applicants respectfully submit that the inventors in the *Schlarb* reference and the inventors in the instant application were obligated to assign to Scientific Atlanta at the times the inventions were made. Consequently, Applicants respectfully submit that the *Schlarb* reference is disqualified as proper cited art. Accordingly, the rejection of claims 21, 22, 24, 25, and 27-60 under 35 U.S.C. §103(a) as allegedly being unpatentable over *Pauley*, *Park* and *Schlarb* is rendered moot. Applicants further respectfully request that the claims be allowed and the rejection be withdrawn.

E. Newly Added Claims 61-62

Applicants respectfully submit that the cited art of record fails to disclose, teach, and suggest each and every element of newly added claims 61-62. Therefore, Applicants respectfully request consideration and allowance of these newly added claims.

***CONCLUSION***

In light of the foregoing amendments and for at least the reasons set forth above, Applicants respectfully submit that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims 21, 22, 24, 25, and 27-62 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned agent at (770) 933-9500.

Respectfully submitted,



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